

Application No. 09/389,082

instant specification. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

The attached Appendix includes marked-up copies of each rewritten claim (37 C.F.R. §1.121(c)(1)(ii)).

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution); (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

Interview

Applicants appreciate the courtesies shown to Applicants' representative by Examiners Cross and Sutton in the January 9, 2002, personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks. Specifically, claim 1 is amended to comply with the Examiner's helpful suggestions made during the interview.

Rejection Under 35 U.S.C. §102(b)

The Office Action rejects claims 1-4, 6 and 8-15 under 35 U.S.C. §102(e) over U.S. Patent No. 5,843,767 to Beattie ("Beattie"). Applicants respectfully traverse the rejection.

Beattie does not teach each and every feature of the claimed invention. Claim 1 is directed to "[a]n assay assembly, comprising: a chip on which an array of reactive species is immobilized; and a storage well having a base and side walls; wherein said chip is separate

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from said base and said chip is located in said storage well." (emphasis added). Beattie does not teach such an assay assembly.

The Office Action asserts that Beattie discloses a nanoporous glass substrate having individual regions/sites for carrying out binding reactions. The Office Action further states that each of the individual regions/sites is defined by a tapered conical well bonded to a face of the glass wafer. Thus, the Office Action reasons, Beattie teaches each and every element of claim 1. However, as discussed during the interview, Beattie does not disclose an assay assembly comprising a chip and a storage well having a base and side walls wherein the chip is separate from the base and the chip is located in the storage well.

In the microfabricated device of Beattie, the substrate, which allegedly approximates the chip of the instant invention, is a single substrate containing a multiplicity of discrete and isolated regions across its surface. Accordingly, the substrate of Beattie, described with respect to the features of claim 1, acts as both chip and base. Claim 1, however, explicitly recites that the chip is separate from the base. For at least this reason, Beattie fails to disclose each and every element of claim 1.

Thus, Beattie does not anticipate the invention of claim 1. Claims 2-4, 8-13 and 15-19 depend from claim 1, and thus also are not anticipated by Beattie. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §103(a)

The Office Action rejects claims 5 and 7 under 35 U.S.C. §103(a) over Beattie in view of GB 2147698 A to Albon et al. ("Albon"). Applicants respectfully traverse the rejection.

For at least the reasons set forth above, Beattie does not teach or suggest the invention of claim 1. Albon does not cure the deficiencies of Beattie.

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The Office Action asserts that Albon teaches projections in storage wells for holding assaying items in place and a test apparatus comprising a holder having a plurality of inserts for reaction wells. However, in spite of these alleged teachings, Albon, like Beattie, fails to teach or suggest an assay assembly comprising a chip and a storage well having a base and side walls wherein the chip is separate from the base and the chip is located in the storage well. In contrast, as discussed during the interview, instant claim 1 explicitly provides such an assay chip. As both Beattie and Albon fail to teach or suggest an assay assembly in which a chip is separate from the base of the well, the combination fails to teach or suggest the invention of claim 1.

Thus, the invention of claim 1 would not have been rendered obvious by Beattie in view of Albon. Claims 5 and 7 depend from claim 1, and thus also would not have been rendered obvious by the cited references. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-13 and 15-19 are earnestly solicited.

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Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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Attachment:
Appendix

Date: PROPOSED

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DEPOSIT ACCOUNT USE
AUTHORIZATION
Please grant any extension
necessary for entry;
Charge any fee due to our
Deposit Account No. 15-0461

Docket No. 104161

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APPENDIX

Changes to Claims:

The following is a marked-up version of the amended claim:

1. (Amended) An assay assembly, comprising:
_____ -a chip on which an array of reactive species is immobilized; and
_____ a storage well having a base and side walls;
_____ wherein said chip being is separate from said base and said chip is located in
said storage well.